

REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 17 to 19, claims 9 to 12, 15, 16 and 20 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

II. Allowed Claims 10 and 12

Applicants note with appreciation the indication that claims 10 and 12 are allowed.

III. Rejection of Claim 17 Under 35 U.S.C. § 102(b)

Claim 17 was rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,845,399 ("Yasuda et al."). While Applicants do not necessarily agree with the merits of this rejection, to facilitate matters, claim 17 has been canceled herein without prejudice, thereby rendering moot the present rejection. Withdrawal of this rejection is therefore respectfully requested.

IV. Rejection of Claims 9, 11, 15, 16 and 18 to 20 Under 35 U.S.C. § 103(a)

Claims 9, 11, 15, 16 and 18 to 20 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Yasuda et al., U.S. Patent No. 5,459,371 ("Okawa et al.") and U.S. Patent No. 6,208,026 ("Bindig et al.").

While Applicants do not necessarily agree with the merits of this rejection, to facilitate matters, claims 18 and 19 have been canceled herein without prejudice, thereby rendering moot the rejection of these claims.

Claim 9 has been amended so as to depend from allowed claim 10. Therefore, claim 9, and claims 11, 15 and 16 which ultimately depend from claim 9, are in immediate condition for allowance.

In regard to claim 20, Applicants respectfully submit that none of the cited references disclose, or even suggest, rail-like extensions having an electrochemically deposited *nickel-alloy*. Yasuda et al. purportedly relate to a laminated piezoelectric transducer. The transducer is stated to include piezoelectric plates 1, inner electrodes 2 and metal extrusions 3 and 4 plated on the side of other alternate inner electrodes 2. See col. 3, lines 5 to 34. The metal extrusions 3 and 4 are stated to be made from *nickel* not from a *nickel-alloy*. See col. 4, lines 37 to 47.

Applicants respectfully submit that Okawa et al. or Bindig et al. do not remedy the deficiencies of Yasuda et al. Nor are Okawa et al. and Bindig et al. relied upon in to remedy the above-noted deficiencies of Yasuda et al.

Okawa et al. purportedly relate to a multilayer piezoelectric element. Okawa et al. state that a nickel plating layer is produced at the end surface of the internal electrodes 22. See col. 8, lines 39 to 45. Okawa et al. do not disclose, or even suggest, use of a nickel-alloy at the end surface of internal electrodes 22.

Bindig et al. purportedly relate to an external electrode for a monolithic multi-layer actuator. A base metallization 4 is stated to be applied to the contact sides of the stack 2. See col. 3, lines 25 to 27. Connection elements 5 are stated to be fastened to this basic metallization 4 by way of solderings or solders 12. See col. 3, lines 27 to 29. The solders 12 are not stated to be made from a nickel-alloy.

Therefore, for the foregoing reasons, the combination of Yasuda et al., Okawa et al. and Bindig et al. do not disclose, or even suggest, all of the limitations of claim 20.

The Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As more fully set forth above, it is respectfully submitted that the combination of Yasuda et al., Okawa et al. and Bindig et al. fails to disclose, or even suggest, rail-like extensions having an electrochemically deposited *nickel-alloy*, as recited in claim 20. It is therefore respectfully

submitted that the combination of Yasuda et al., Okawa et al. and Bindig et al. does not render obvious claim 20.

Withdrawal of this rejection is therefore respectfully requested.

V. **Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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